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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,355	07/12/2000	Michael L. O'Banion	0275A0103COF	2199

7590 10/02/2002

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EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/614,355

Applicant(s)
Miller et al.

Examiner
Clark F. Dexter

Art Unit
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 16, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 10, 11, 14, 15, and 22-26 is/are pending in the application.
- 4a) Of the above, claim(s) 2-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 11, 14, 15, and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. The amendment filed July 16, 2002 has been entered. It is noted that in view of the new amendment practice under 37 CFR 1.121 which became mandatory for all amendments on March 1, 2001, and due to the limited amount of examining time per application, if the amendment contains changes to existing language that requires a marked-up version showing those changes, the Examiner is relying upon the marked-up version(s) for examination of the application. It is applicant's responsibility to ensure that the clean version(s) is (are) the same as the marked-up version(s). It is further noted that the clean version(s) is (are) considered to be the Official version(s).

Claim Rejections - 35 USC § 112

2. Claims 1, 10, 11, 14, 15 and 22-26[✓] are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not provide support for a cutting tool that is movable to both a second and third position as now claimed. Rather, support appears to be provided for a cutting tool that is movable to one of these positions, not both (e.g., see Figures 6 and 9).

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Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 10, 11, 14, 15 and 22-26[✓] are rejected under the judicially created doctrine of non-statutory double patenting over claims 1-47 of U.S. Patent No. 5,297,463. Although the conflicting claims are not identical, they are directed to the same inventive concept and are not patentably distinct from each other because the subject matter of the application claims is fully disclosed in the patent specification and covered by the patented claims. The patented claims are inclusive for they are drafted using the "comprising-type" format and cover the subject matter of the application claim(s). Since applicant has obtained the right to exclude others from making and using the subject matter set forth in the claims of this application by virtue of the patented claims, the issuance of this application into a patent without a terminal disclaimer as provided for under 37 CFR § 1.321(b) would amount to an unjustified extension of this right.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 10, 11, 14, 15 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viazanko, pn 4,798,113, in view of Brundage et al., pn 4,934,233.

Viazanko teaches or suggests almost every structural limitation of the claimed invention but lacks the cutting tool being movable to second and third positions as now claimed. However, the Examiner takes Official notice that such cutting tools that are capable of such positions, commonly known as compound miter saws, are old and well known in the art as evidenced by Brundage et al. and provide various well known benefits including manufacturing flexibility. Therefore, it would have been obvious to one having ordinary skill in the art to replace the cutting tool of Viazanko with a compound miter saw for the well known benefits including that described above.

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Regarding claims 10, 11, 14, 15 and 25, Viazanko discloses a saw with almost every structural limitation of the claimed invention but lacks a fixed clamping means otherwise referred to as a first anti-removal means, a second antiremoval means, a first member, and a second member. However, the Examiner takes Official notice that it is old and well known in the art to provide a clamping means such as a screw or set screw to lock two slidably adjustable components in place with respect to one another. Such clamping means are well known in various arts for securing slidably adjustable components in a desired position with respect to one another. Therefore, it would have been obvious to one having ordinary skill in the art when wanting to prevent the movable fence portion from moving with respect to the fixed fence portion to provide any well known means including clamping means in the form of screws or set screws in the fixed fence portion (e.g., 20) of Viazanko to secure the movable fence portion (e.g., 160) in a desired position.

7. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Viazanko, pn 4,798,113, in view of ^{Brundage et al.,} as applied to claim 22 above, and further in view of Novak, pn 3,901,498.

The combination teaches and/or suggests a saw with almost every structural limitation of the claimed invention but lacks a fixed clamping means. However, the Examiner takes Official notice that it is old and well known in the art to provide a fixed clamping means such as a screw or set screw to lock two slidably adjustable components in place with respect to one another. Such clamping means are well known in various arts for securing slidably adjustable components

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in a desired position with respect to one another. Therefore, it would have been obvious to one having ordinary skill in the art when wanting to prevent the movable fence portion from moving with respect to the fixed fence portion to provide any well known means including fixed clamping means in the form of screws or set screws in the fixed fence portion (e.g., 20) of Viazanko to secure the movable fence portion (e.g., 160) in a desired position.

The combination further lacks a movable clamping means fixedly interconnected with the movable fence portion. However, movable clamping means are old and well known in the art as evidenced by Novak wherein a movable clamping means (e.g., as best shown in Figures 1 and 4) is provided to fix the movable fence portion in place. Therefore, it would have been obvious to one having ordinary skill in the art when wanting to prevent the movable fence portion from moving with respect to the fixed fence portion to provide any well known means including movable clamping means, e.g., in the form of a screw or the like in the movable fence portion (e.g., 144, 160) as taught in Novak to secure the movable fence portion in a desired position.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3590; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd
October 1, 2002